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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/596,439

06/14/2006

Adrian Shulman

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YORAM TSIVION

P.O. BOX 1307

PARDES HANNA, 37111

ISRAEL

EXAMINER

RAMANA, ANURADHA

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/596,439 | <b>Applicant(s)</b><br>SHULMAN, ADRIAN |  |
|                              | <b>Examiner</b><br>Anu Ramana        | <b>Art Unit</b><br>3775                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-18, and 20 is/are rejected.
- 7) ☒ Claim(s) 14-16 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/8/08 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Brosens et al. (US 6,156,006).

Brosens et al. disclose a vaginal speculum assembly including: a first jaw 640 having a first truncated engagement portion; a second jaw 642 pivotally connected to the first jaw, the second jaw having a second engagement portion; a first handle portion generally perpendicular to the first engagement portion; a second handle portion generally perpendicular to the second engagement portion; and a guide section or "mounting mechanism" 642 removably mounted to the first jaw to support an instrument or "inspection device" or combined Veress needle guide and ultrasound probe apparatus 700 wherein the mounting mechanism is detachable from the first jaw (Figs. 18-19 and col. 17, lines 21-52 and col. 18, lines 1-13).

Claims 1-6, 8-10, 13, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US 3,320,948).

Martin discloses a vaginal speculum assembly including: a first jaw 11 having a first truncated engagement portion; a second 14 pivotally connected to the first jaw, the second jaw having a second engagement portion; a first handle portion generally perpendicular to the first engagement portion; a second handle portion 23 generally perpendicular to the second engagement portion; and a mounting mechanism 4 removably mounted to the first jaw to support an instrument or "inspection device" wherein the mounting mechanism is detachable from the first jaw. The mounting

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mechanism includes a locking mechanism or fastener 61 that prevents movement of the inserted instrument with respect to the first jaw. Martin further discloses the mounting mechanism to have a rocker or housing or first clamping element 40 connected to a shaft 31 and a second clamping element 35 pivotally receiving first clamping element 40 (Fig. 3, col. 3, lines 44-75, col. 4 and col. 5, lines 1-15).

With regard to the recitation in claim 13, "adapted to be inserted through a channel in said first jaw," it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosens et al. (US 6,156,006) in view of Tepper (US 6,371,973).

Brosens et al. disclose all elements of the claimed invention except for the specific details of the mounting mechanism or mounting configuration.

Tepper teaches an instrument mount including: a housing 32; first clamping element 34; a second clamping element or locking mechanism 35 that when engaged or locked to second clamping element 35 prevents movement of an instrument such as an ultrasound probe with respect to the instrument that it is attached to; and a fastener or pins 44 that secure the first clamping element to housing 32 (Fig. 3, col. 7, lines 26-67 and col. 8, lines 1-17).

The substitution of one known instrument mounting mechanism (as taught by Tepper) for another known instrument mounting mechanism (as disclosed by Brosens

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et al.) would have been obvious to one of ordinary skill in the art at the time of the invention since this amounts to simple substitution of one known type of mounting mechanism for another and would have yielded predictable results, namely, removable attachment of an ultrasound probe to an instrument, for e.g. a speculum.

With regard to the limitation "adapted to be inserted through a channel in said first jaw," it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US 3,320,948) in view of Wong et al. (US 6,969,166).

Martin discloses all elements of the claimed invention except for an instrument such as an ultrasound probe.

Wong et al. teach attaching an instrument, for e.g. an ultrasound probe, to a speculum, to permit ultrasound visualization during procedures.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have attached an instrument, such as an ultrasound probe, as taught by Wong et al., to the Martin device to enable ultrasound visualization during procedures, since it was well known in the art to attach an instrument, such as an ultrasound probe, to a speculum.

### ***Allowable Subject Matter***

Claims 14-16 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
March 14, 2009

/Anu Ramana/  
Primary Examiner, Art Unit 3775